

REMARKS/ARGUMENTS

Reconsideration of this application as amended is respectfully requested. Claims 1 and 36 have been amended, claim 34 has been cancelled, and claims 2 and 33 were previously cancelled. Accordingly, claims 1, 3-32 and 35-36 remain in this application and are again presented for the Examiner's consideration in view of the following comments.

It is respectfully submitted that good cause has been demonstrated for the entry of the present amendment, not only since it overcomes the Examiner's rejections as set forth in the Official Action, thus clearly reducing the number of issues for purposes of appeal, but since the present response places all of the remaining claims in condition for immediate allowance, as will be more clearly demonstrated below.

In the Official Action, claims 1, 3-26, 29-32, 34 and 35 were rejected under 35 U.S.C. § 103(a) as being obvious over Japanese Patent No. 55-136409 to Anakama ("*Anakama*") in view of U.S. Patent No. 5,918,994 to Gueret ("*Gueret I*") and U.S. Patent No. 3,343,551 to Anderson ("*Anderson*"). Claim 34 has been cancelled. Applicant respectfully traverses this rejection with respect to claims 1, 3-26, 29-32 and 35 for the reasons set forth below.

Applicant initially notes the requirement in claim 1 for

said wiper member being disposed in said
receptacle such that said wiper member wipes
said brush as said brush is withdrawn from
said receptacle

As applicant has noted previously, neither *Anakama*, *Gueret I* nor *Anderson* teaches such a wiper member which contacts the brush when the brush forms an angle of greater than 0° relative to the longitudinal axis of the rod as required by claim 1.

Anakama plainly teaches away from this feature. That

is, *Anakama* teaches that "the applicator wand (2) and the applicator bristles (3) can be brought out smoothly, without dragging or catching anything at all." (*Anakama* translation, p. 8.) This portion of *Anakama* refers to the oval insertion opening (5) which facilitates removal of the applicator brush from the receptacle when the bristles are properly aligned with the insertion opening during removal. As such, this is a clear teaching by *Anakama* that his wiper member is configured **not** to contact the brush as the brush is withdrawn from the receptacle.

Turning next to *Anderson*, nothing in the reference discloses anything about the receptacle containing the mascara, and certainly nothing in the reference provides any disclosure whatsoever about a wiper member in a receptacle. Accordingly, *Anderson* fails to overcome the deficiencies of *Anakama* noted above.

While *Gueret I* discloses a receptacle having a wiper member (*Gueret I*, Fig. 9 and col. 6, lns. 25-29), this teaching is in the context of a straight applicator, i.e., an applicator having an angle of 0° between the bristles and the rod. (*Gueret I*, Fig. 9.) Nothing in *Gueret I* suggests a bristle portion disposed at an angle to the longitudinal axis of the rod, and therefore nothing in the reference suggests that in such embodiment, a wiper member should be disposed in the receptacle such that the wiper member wipes the brush as the brush is withdrawn from the receptacle.

Thus, neither *Anakama*, *Anderson* nor *Gueret I* teaches or suggests a wiper member as claimed. This is one basis by which claim 1 distinguishes over these references.

As it has done in its prior responses, applicant also directs the Examiner's attention to the requirement in claim 1 for

said twisted-wire core being bent such that
substantially all points of said

bristle-carrying portion form an angle greater than 0° and less than about 20° relative to said longitudinal axis of said end portion of said rod.

Applicant reiterates the contention it has previously made that nothing in *Anakama*, *Gueret I* or *Anderson* suggests a range of angles of greater than 0° and less than about 20° as required by this claim.

The *Anakama* reference teaches that the bristle portion of the applicator is oriented at an angle of about 30° with respect to the wand portion of the applicator. (*Anakama* translation, p. 7 of source.) According to *Anakama*, the purpose of inclining the bristles at such an angle with respect to the wand is to space the wand away from the cheek and other portions of the user during application, thereby eliminating the problem of mascara from the wand being deposited on the user in places other than the eyelashes. (*Anakama* translation, p. 8 of source.) Nowhere does *Anakama* suggest that the angle between the bristle portion and the wand portion of the applicator can or should be less than about 30°. Rather, it can be readily seen that smaller angles would space the wand of the applicator closer to the user's face, rendering contact with the user's cheek much more likely. Thus, the use of angles less than those suggested by *Anakama* would be antithetical to the very purpose of *Anakama* and would be in total disregard to the teachings of the reference. Without question, *Anakama* **teaches away** from implementing an applicator with angles that are less than about 30°.

Gueret I provides no teaching whatsoever of an angle between the bristle-carrying portion and the longitudinal axis of the end portion of the rod. That is, the *Gueret I* merely teaches that the bristle-carrying portion and the rod should form a continuous straight line. For this reason, *Gueret I* fails to overcome the deficiencies of *Anakama* noted above.

As noted by the Examiner, *Anderson* teaches an angle between the bristle-carrying portion and the longitudinal axis of the rod of 0° - 60°. However, the Examiner has failed to establish a *prima facie* case that it would have been obvious to combine the teachings of *Anakama* and *Anderson*. That is, the Examiner's statement that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the angle of *Anakama* to be at a range of 0-60 degrees in order to accommodate different users" is merely conclusory and has no basis. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 U.S.P.Q. 2d 1385 (2007).

Anakama expressly teaches that an angle of about 30° is necessary to keep the applicator from contacting the cheek of the user. Granted, different people have differently shaped faces, but applicant fails to see how applicator angles of 0°-60° would be needed to accommodate these different users. Rather, the skilled artisan having knowledge that an applicator angle of at least 30° is **required** by the very purpose of *Anakama* would have no reason whatsoever to look at the wide range of angles of *Anderson*, and particularly those that are less than 30°. Such smaller angles would not avoid the cheek of the user and would thus frustrate the solution to the problem achieved by *Anakama*. The *Anderson* reference itself realizes this problem by stating that "handle portion 20 is angled with respect to base 10 to provide convenience of handling and possible clearance away from eyebrow 22." (*Anderson*, col. 3, lns. 42-44.) Thus, *Anderson* appreciates that significant applicator angles are necessary in order to provide clearance from the remainder of the user's face, such that the combination of *Anderson* and

Anakama would still not lead one skilled in the art to the smaller angles set forth in claim 1.

Moreover, the Examiner has contended that forming the applicator with an angle of greater than 0° and less than about 20° as set forth in claim 1 would merely be an optimization of a range of angles disclosed in the prior art. Applicant most strongly disagrees with the Examiner's position. In order for the optimization of a parameter to be characterized as a matter of routine experimentation and hence obvious, that parameter must first be recognized as a result-effective variable. MPEP 2144.05 citing *In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (CCPA 1977). Nowhere does the art of record suggest in any way that the angle between the bristle-carrying portion and the rod is a result-effective variable for the amount of material retained on the bristles. The Examiner's statement that it would be obvious to one of skill in the art to optimize such angle misses the point. The skilled artisan would have to appreciate that changing such angle would have an effect on the amount of material retained on the bristles. Nothing of record in the present case remotely suggests such effect. Indeed, it is the applicant who discovered this effect and who is claiming it herein. In this regard, the decision by the Board of Patent Appeals and Interferences in *Ex parte Whalen*, 89 U.S.P.Q.2d 1078 (B.P.A.I. 2008), is particularly instructive. In that decision, the Board stated "the Examiner has not pointed to any teaching in the cited references, or provided any explanation based on scientific reasoning, that would support the conclusion that those skilled in the art would have considered it obvious to 'optimize' the prior art compositions by increasing their viscosity to the level recited in the claims." *Id.* at 1084. The same rationale can be applied in the present case to the Examiner's failure to provide a satisfactory reason that one skilled in the art would select the range of angles claimed

herein.

In view of the foregoing, applicant submits that claim 1 patentably distinguishes over the combination of *Anakama*, *Gueret I* and *Anderson* such as to warrant its immediate allowance, which action is respectfully requested.

Claims 3-26, 29-32 and 35 depend either directly or indirectly from claim 1 and include all of the limitations of that claim. For at least this reason, applicant submits that these dependent claims also distinguish patentably over the combination of *Anakama*, *Gueret I* and *Anderson* such as to warrant their immediate allowance, which action is respectfully requested.

In addition, applicant notes the following requirement in claim 4:

said bristle-carrying portion includes a middle and a distal end portion extending from said middle to a free end of said bristle-carrying portion, said longitudinal axis of said end portion of said rod intersecting said envelope surface of said distal end portion.

As is clearly evident, *Anakama*, *Gueret I* and *Anderson* are all silent with respect to this feature. This is another reason why applicant believes claim 4 distinguishes over these references.

Claim 10 requires the remote end of the core to be situated at a distance of less than about 7.5 mm from the longitudinal axis of the end portion of the rod; and claim 11 requires this distance to be less than about 4.5 mm. As nothing in either *Anakama*, *Gueret I* or *Anderson* suggest this structural relationship, applicant submits that this is an additional reason why claims 10 and 11 distinguish patentably over these references.

Claim 35 requires the wiper member to have an orifice of circular cross-section. As discussed above, *Anakama* teaches

that the wiper member should have an oval opening so that the angled brush portion can be removed from the receptacle "without dragging or catching on anything at all." Hence, even if *Gueret I* were to teach a wiper member having an orifice with a circular cross-section, a skilled artisan would have no motivation to combine this teaching of *Gueret I* with *Anakama* as to do so would directly contradict the teaching of *Anakama* that dragging or catching on the wiper member is undesirable.

Claims 27, 28 and 36 were rejected under 35 U.S.C. § 103(a) as obvious over *Anakama* in view of *Gueret I*, *Anderson* and U.S. Patent No. 5,462,798 to *Gueret* ("*Gueret II*"). This rejection is respectfully traversed in view of the above amendments and arguments and for the reasons set forth below.

Applicant would initially note that claim 36 includes the same limitation as claim 1 discussed above, namely, "said wiper member being disposed in said receptacle such that said wiper member wipes said brush as said brush is withdrawn from said receptacle." In addition, claim 36 includes the requirement that

the twisted-wire core being bent such that substantially all points of the bristle-carrying portion form an angle greater than about 5° and less than about 10° relative to the longitudinal axis of the end portion of the rod.

Applicant submits that neither *Anakama*, *Gueret I* or *Anderson* suggests this range of angles. Further, applicant submits that the arguments set forth above regarding the range of angles of greater than 0° and less than about 20° as required by claim 1 are equally applicable to the range of angles required by claim 36.

Additionally, applicant notes that claims 27 and 28 depend from claim 1 and therefore include all of the limitations of that claim. As such, applicant would reiterate the contentions

set forth above with regard to the manifest deficiencies of *Anakama, Gueret I* and *Anderson*, and in particular, in their attempted combination. *Gueret II* fails to overcome these deficiencies. Accordingly, applicant submits that claims 27, 28 and 36 patentably distinguish over *Anakama, Gueret I, Anderson* and *Gueret II* such as to warrant their immediate allowance. In view of the foregoing, withdrawal of this rejection is respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which she might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: June 22, 2010

Respectfully submitted,
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